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QUALCOMM INCORPORATED
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EXAMINER

HO, DUC CHI

ART UNIT PAPER NUMBER

2616

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/079,956

Applicant(s)

PADOVANI ET AL.

Examiner

Duc C. Ho

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 24-28 and 30-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Objections

1. Claims 25-26, and 30-31 are objected to because of the following informalities:

Regarding claims 25-26, these claims are in dependency to the canceled claim 23.

Regarding claims 30-31, these claims are in dependency to the canceled claim 29.

Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, and 5-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, 13-14, respectively, of U.S. Patent No. 7,072,628. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Regarding claim 1, see lines 1-5 (see claim 7 of U.S. Patent No. 7,072,628 at col.12).

Regarding claim 5, see lines 1-4 (see claim 13 of U.S. Patent No. 7,072,628 at col.13).

Regarding claim 6, see lines 1-5 (see claim 14 of U.S. Patent No. 7,072,628 at col.13).

For claim 1, Applicant merely broadens the scope of claim 7 of U.S. Patent No. 7,072,628 by eliminating the limitation "and duration of said channel condition" at col. 12, lines 25-26, and "and said duration" at col. 12, line 30.

For claim 5, Applicant merely broadens the scope of claim 13 of U.S. Patent No. 7,072,628 by replacing "said enable-receive-diversity and disable-receive-diversity" with "said first and second channel condition" in claim 5 of the instant application.

For claim 6, Applicant keeps the scope of claim 14 of U.S. Patent No. 7,072,628 the same as that of claim 6 of the instant application.

It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969);

Art Unit: 2616

therefore omission of a reference element whose function is not needed would be obvious to one skilled in the art.

4. Claims 7, 11, and 12-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, 13, and 14, respectively, of U.S. Patent No. 7,072,628. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Regarding claim 7, see lines 1-6 (see claim 7 of U.S. Patent No. 7,072,628 at col.12).

Regarding claims 11, lines 1-3 (see claim 13 of U.S. Patent No. 7,072,628 at col.13).

Regarding claims 12 &13 (see claim 14 of U.S. Patent No. 7,072,628 at col.13).

For claim 7, Applicant merely broadens the scope of claim 7 of U.S. Patent No. 7,072,628 by eliminating the limitation "and duration of said channel condition" at col. 12, lines 25-26, and "and said duration" at col. 12, line 30.

For claim 11, Applicant merely broadens the scope of claim 13 of U.S. Patent No. 7,072,628 by replacing "said enable-receive-diversity and disable-receive-diversity" with "said first and second channel condition" in claim 5 of the instant application.

For claims 12-13, Applicant keeps the scope of claim 14 of U.S. Patent No. 7,072,628 the same as that of claims 12-13 of the instant application.

It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); therefore omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(b) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Rich (US 5,940,452).

Regarding claim 1, Rich discloses dual mode radio subscriber unit having a diversity receiver apparatus and method therefore.

a receiver, including a plurality of receiver chains, for receiving a pilot channel and determining a channel condition of said pilot channel (a radio subscriber unit 102-fig.1 includes two antennas 114, 116, or receiver chains for receiving a carrier to interference ratio E_c/I_o of a pilot channel, see col. 4, line 32-42);

a control system for controlling receive diversity of said receiver by selecting a number of said plurality of receiver chains based on said determined channel condition (a controller 108-fig.1 controls the selection the first antenna 114 and the second antenna 116-fig.1 based on the interference ratio, see col.7-line 52 to col.8-line 3, col.10, lines 32-46).

Regarding claim 2, Rich discloses the steps 202, 204-206, fig.2 in response to the S RSSI (the ratio of E_c/I_o) greater than a predetermined threshold, that the controller 108-fig.1 selects either the first or the second antenna, see col. 13-line 49 to col. 15-line 19.

Regarding claim 3, Rich's system is capable of reducing the number of antennas when the S RSSI (or the ratio E_c/I_o) is below a second condition threshold.

Regarding claim 4, this claim has similar limitations as claims 2, and 3.

Therefore, it is rejected under Rich for the same reasons set forth in the rejection of claims 2, and 3.

Regarding claims 7-10, these claims have similar limitations as claims 1-4, respectively. Therefore, they are rejected under Rich for the same reasons set forth in the rejection of claims 1-4.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 14-22, 24-28, and 30-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rich, in view of Willey (US 6,505,058).

Regarding claim 14, Rich discloses all claimed limitations, except determining a first data bit of the QPCH received a mobile station in accordance with processing of one or more signals produced based on the determined receive diversity.

One skill in the art would recognize the advantage of employing a single bit message of QPCH based on a determined diversity to direct a mobile station so that the mobile station can configure itself to sleep mode or not in accordance with the data bit in order to save the battery power within a single charge.

Willey discloses a method for determining whether to wake up a mobile station. The mobile station receives a QPCH bit representing by "On" (corresponding to 1), "Off" (corresponding to zero), and "not certain" (corresponding to erasure). "On" also means the base station's clearly transmitted the bit. This further means that the mobile station should not in sleep mode, so that it could receive data from the base station, see col. 5, lines 56-67, and col.5-line 45 to col.6-line 7.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Rich with Willey.

The suggestion/motivation for doing so would have been to provide a mobile station a capability of using a single bit message of QPCH, transmitted from the base station, based on a determined diversity to indicate a mode in such a way a mobile station can configure itself to sleep mode or not in accordance with the data bit in order to save its battery power within a single charge.

Therefore, it would have been obvious to combine Rich with Willey to obtain the invention as specified in claim 14.

Regarding claim 15, the system of Rich-Willey enables a mobile station in sleep mode when the determined first data bit is "Off".

Regarding claim 16, the system of Rich-Willey should indicate a mobile station not in sleep mode when the determined first data bit is "On" or "not certain".

Regarding claim 17, the system of Rich-Willey should direct its resource to decode the received information when the determined first data bit is "On" or "not certain".

Regarding claim 18, the system of Rich-Willey enables a mobile station in sleep mode when the determined second data bit is "Off".

Regarding claims 19-20, these claims have similar limitations as claims 14-15, respectively. Therefore, they are rejected under Rich-Willey for the same reasons set forth in the rejection of claims 14-15.

Regarding claims 21, this claim has similar limitations as claims 17-18. Therefore, it is rejected under Rich-Willey for the same reasons set forth in the rejection of claims 17-18.

Regarding claims 22, this claim has similar limitations as claims 14, and 16. Therefore, it is rejected under Rich-Willey for the same reasons set forth in the rejection of claims 14, and 16.

Regarding claim 24, this claim has similar limitations as claim 15. Therefore, it is rejected under Rich-Willey for the same reasons set forth in the rejection of claim 15.

Regarding claim 25, this claim has similar limitations as claims 16-17. Therefore, it is rejected under Rich-Willey for the same reasons set forth in the rejection of claims 16-17.

Regarding claim 26, this claim has similar limitations as claims 16, and 18. Therefore, it is rejected under Rich-Willey for the same reasons set forth in the rejection of claims 16, and 18.

Regarding claims 27-28, these claims have similar limitations as claims 14-15, respectively. Therefore, they are rejected under Rich-Willey for the same reasons set forth in the rejection of claims 14-15, respectively.

Regarding claims 30-31, these claims have similar limitations as claims 25-26, respectively. Therefore, they are rejected under Rich-Willey for the same reasons set forth in the rejection of claims 25-26, respectively. The mobile station of Rich is able to direct the battery power supply to receive a receive channel in response to the result of either a one or an erasure of Willey's bit.

Regarding claim 32, this claim has similar limitations as claims 14-17. Therefore, it is rejected under Rich-Willey for the same reasons set forth in the rejection of claims 14-17. The mobile station of Rich is able to direct the battery power supply to receive a receive channel in response to the result of either a one or an erasure of Willey's bit.

Regarding claim 33, in Rich the controller 108-fig. 1 is capable of directing the mobile resources, i.e., battery power supply, to receive a receive channel, after the receive diversity at the receiver, in accordance with a receive processing of the determined receive diversity.

Art Unit: 2616

Regarding claim 34, this claim has similar limitations as claims 31-32. Therefore, it is rejected under Rich-Willey for the same reasons set forth in the rejection of claims 31-32.

Regarding claim 35, this claim has similar limitations as claim 33. Therefore, it is rejected under Rich-Willey for the same reasons set forth in the rejection of claim 35.

Regarding claim 36, this claim has similar limitations as claim 32. Therefore, it is rejected under Rich-Willey for the same reasons set forth in the rejection of claim 32.

Regarding claim 37, this claim has similar limitations as claim 17. Therefore, it is rejected under Rich-Willey for the same reasons set forth in the rejection of claim 17.

Regarding claim 38, if the bit of Willey is an erasure based on the condition of the pilot channel received at the receiver of Rich, a condition in which the channel condition is below the threshold, the controller 108-fig.1 of Rich directing the battery power supply and the antennas to receive a receive channel.

Regarding claim 39, this claim has similar limitations as claim 36. Therefore, it is rejected under Rich-Willey for the same reasons set forth in the rejection of claim 36.

Regarding claim 40, this claim has similar limitations as claim 17. Therefore, it is rejected under Rich-Willey for the same reasons set forth in the rejection of claim 17.

Regarding claim 41, this claim has similar limitations as claim 38. Therefore, it is rejected under Rich-Willey for the same reasons set forth in the rejection of claim 38.

Allowable Subject Matter

10. Claims 5-6, 11-13 are objected to as being independent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and if the rejected base claim has overcome the obviousness-type double patenting.

Response to Arguments

11. Applicant's arguments with respect to claims 1, 7, 14, 19, 22, 27, 32, 34, 36, and 39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Ho whose telephone number is (571) 272-3147. The examiner can normally be reached on Monday through Friday from 7:00 am to 3:30 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (571) 272-3134.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2616

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

A handwritten signature in black ink, appearing to read 'Duc Ho', with a stylized flourish at the end.

Duc Ho

10-20-06